

Remarks/Arguments:

Claim 22 is amended for clarity. Support for the amendments to claim 22 is found throughout the specification, and particularly, as shown in the figures. Claims 1-22 are pending with claims 1, 21, and 22 as the independent claims.

I. The Office Action Rejections

Claims 8, 9, and 21 are objected to under 35 U.S.C. § 112 as omnibus claims. Claims 1, 2, 10, 19, and 20 stand rejected under 35 U.S.C. § 102(b) as anticipated by DeVito (U.S. Patent No. 5,960,572). Claim 22 stands rejected 35 U.S.C. § 102(e) as anticipated by Mahoney et al. (U.S. Patent No. 6,957,755). Claims 3-7, 11-18 stand rejected under 35 U.S.C. § 103(a) as unpatentable over the DeVito reference in view of numerous other references.

II. Applicant's Remarks

A. Claims 8, 9, And 21 Are Not Omnibus Claims

The MPEP § 2173.05(r) discusses an omnibus claim, which is identified by the specific language of "a device as substantially shown and described." This language does not appear in any pending claims, including claims 8, 9, and 21. Accordingly, the applicant submits the rejection is in error and respectfully requests that it be withdrawn.

The grasshopper clip recited in claims 8, 9, and 21, is shown in Figure 4E and is described in the specification at page 7, lines 16-18. The applicant submits that the figure and description satisfy the written description and enablement requirements of 35 U.S.C. § 112.

B. Lack of Anticipation

1. Independent Claim 1 And Claims Depending Therefrom

DeVito fails to disclose the claimed feature of "a mounting apparatus affixed to the rear panel for attaching the device holder to the vehicle."

The Office Action characterizes DeVito as disclosing that "the mounting apparatus (28) [is] affixed to the rear panel (29) to attach the device holder (10) to the vehicle (26)." The applicant disagrees with this rejection on at least two bases. First, the rejection erroneously identifies reference numeral 29 as a rear wall. The specification at col. 4, line 47 of DeVito refers to reference numeral 29 as a "front surface" not a "rear wall." Front surface 29 of DeVito borders a "large open front window 16." Col. 4, lines 36-37. Second, the rejection erroneously

identifies that "the mounting apparatus (28) [is] affixed to the rear panel (29) to attach the device holder (10) to the vehicle (26)." The mounting apparatus, *i.e.*, the suction cups 28 (see col. 4, line 46), "extend[s] outwardly from the front panel 28 and adjacent a **corner bottom end** of the housing 12 below the large open front window 1." (emphasis added). The corner bottom is identified by facility 30, appearing on the sides of DeVito "for angularly adjusting both of the suction cups 28 on the housing 10." Col. 4, lines 49 and 50. The facility 30 is illustrated in the side view of Fig. 2 of DeVito, reproduced at right.

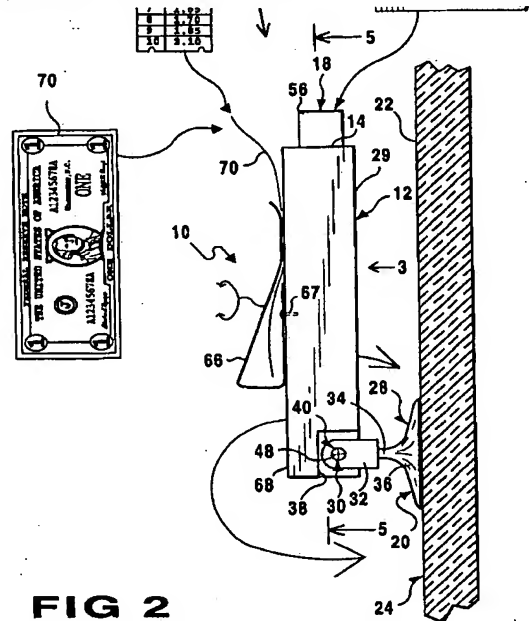


FIG 2

As is clearly shown in Fig. 2, "each suction cup 28 consists of a base portion 32, with a shaft portion 34 extending from the base portion 32." Col. 4, lines 58-60. The base portion 32 is coupled to facility member 30 on the side of DeVito. Thus, the mounting apparatus or suction cup of DeVito is not "affixed to the rear panel for attaching the device holder to the vehicle," as is recited in the applicant's claim 1.

A reason that facility 30 is pivotably mounted to the side of the housing in DeVito is so that "the housing 12 can swing down to a generally horizontal position, to allow the electronic toll pass 18 to be inserted and removed from the open top compartment 14." Col. 4, lines 53-55. A reason that facility 30 is not mounted to the front surface of the device in DeVito may be because "toll pass holder 10 comprises a housing 12 having an open top compartment 14 with a large open front window 16." Col. 4, lines 36 and 37. "The large open front window 16 in the housing 12 faces the interior surface 22 of windshield 24, so that the electronic toll pass 18 can operate therefrom." Col. 4, lines 41-43. As a result, DeVito shows facility 30 mounted to base 32, which in turn is pivotably mounted to the side of DeVito, as shown and discussed above.

Thus, the applicant contends that DeVito does not teach or suggest "the mounting apparatus affixed to the rear panel" as recited in the applicant's claim 1.

Claims 2, 10, 19, and 20 are also not disclosed nor suggested by DeVito as they depend, either directly or indirectly from claim 1. For at least the same reason claim 1 is not anticipated or rendered obvious by the disclosure of DeVito, the applicant contends that claims 2, 10, 19, and 20 are also not anticipated or rendered obvious.

2. Independent Claim 22

Mahoney, specifically Fig. 2, fails to disclose the claimed feature of a first, middle, and second surface where the first and middle surface are spaced apart to define an opening for an electronic toll pass, and the middle and second surface define a retaining device. The rejection purports that, with reference to Fig. 2 of Mahoney, receptacle wall 14, back edge of receptacle wall 14.1, and back panel 12 are the claimed first, second, and middle surfaces. In addition, the Office Action contends that slot 11 is the retaining device recited in the claims. The applicant respectfully disagrees.

What is illustrated in Fig. 2 of Mahoney, reproduced at right, is only two panels or two surfaces that define only a shallow, hollow receptacle 200. Receptacle 200 is defined by back panel 12 and front wall 14, forming only surface #1 and surface #2, respectively. The applicant's recited middle surface is lacking in Mahoney. What the Office Action identifies as the middle surface is the front face (reference numeral 14.1) of back panel 12.

In addition, the applicant contends that the amendments to claim 22 render moot the Office Action rejection. Claim 22 is amended to clarify that "the second and middle surface define a retaining device along substantially the entire length of the second and middle surface." In contrast to this claim requirement, back panel 12 defines slot 11 only in the top portion of panel 12. The bottom portion (near reference numeral 18) is solid. Thus, in contrast to the recitation of claim 22, Fig. 2 of Mahoney does not show a second surface and a middle surface defining "a retaining device along substantially the entire length of the second and middle surface." For at least this reason, claim 22 is not anticipated or rendered obvious by Mahoney.

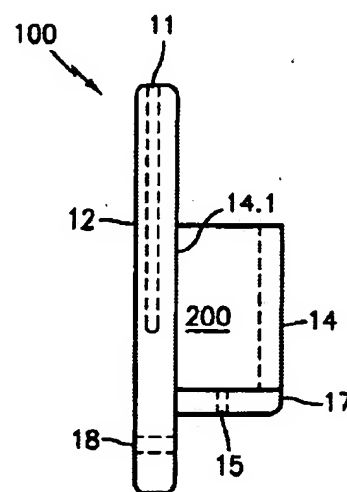


FIG. 2

C. Lack of Obviousness

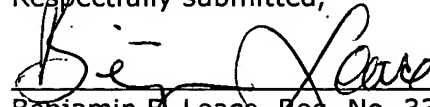
Claims 2-20 depend either directly or indirectly from claim 1. The applicant contends that these dependent claims are allowable for the reasons set forth above with respect to claim 1.

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III. Conclusion

For the reasons set forth above, the applicant contends that the pending claims are neither anticipated nor rendered obvious by the art of record. Reconsideration of the claims and the rejections is respectfully requested.

Respectfully submitted,



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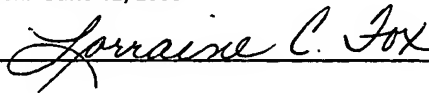
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